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**DIRECTOR'S OFFICE
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CUSHMAN, DARBY & CUSHMAN
1100 NEW YORK AVENUE, N.W.
9TH FLOOR, EAST TOWER
WASHINGTON, D.C. 20005-3918

In re application of:

Yuichiro Itakura et al.

Application No. 09/923,846

Filed: August 7, 2001

For: PURCHASING ON-LINE USING A PARAMETER
IN A DATABASE

:
: **DECISION ON REQUEST**
: **FOR WITHDRAWAL OF**
: **ATTORNEY**

This is a decision on the renewed petition filed on January 21, 2004, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

- A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;
- B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and
- C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney in the above-identified application is not approved because the request does not comply with items A) and B) above.

As to item A), the attorney making the request does not now have, and apparently never has had, power of attorney in this application.

This application was filed on August 7, 2001 and included an application data sheet listing a correspondence address associated with customer no. 27934 of which Mr. Sereboff is listed as an attorney. In response to a Notice to File Missing Parts mailed December 18, 2001 (signature of inventor missing on oath/declaration), applicant submitted a copy of the declaration filed in the parent application. It is noted that the file does not currently contain an originally filed oath/declaration. The declaration filed in the parent application granted power of attorney to attorneys associated with the law firm of Cushman & Darby at the address noted above. A change of address to customer no. 33356 was filed on August 20, 2002 and signed by Mr. Sereboff; however, the address change is improper because Mr. Sereboff does not have the right to change the address. As noted in MPEP § 601.03:

Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. 37 CFR § 1.63(d)(4).

There is no record of power of attorney ever being given to the attorney making the request. The declaration filed on March 5, 2002 does not include a power of attorney for the requesting attorney, Steven Sereboff, or attorneys associated with either customer no. 27934 or 33356. Further, no separate paper conferring power of attorney to the attorney(s) making the request has been filed.

As to item B), the stated reason for withdrawal is that the assignee (client) has terminated the relationship with Mr. Sereboff. The "client" referred to in 37 CFR 10.40 is seen as being those individuals who conferred power upon the attorney(s). It is unclear who the "client" is since Mr. Sereboff was not granted power of attorney by the inventors. A statement under 37 CFR 3.73(b) to establish ownership must be provided.

For this decision only a copy of this correspondence will be sent to the SoCal IP Law Group.



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SNM/mjz: 5/3/04

cc: SOCAL IP LAW GROUP
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